



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

VOTIPKA, Bruce, *et al.*

Serial No. 09/675,514

Filing Date: September 29, 2000

For: METHOD AND APPARATUS FOR
CONTROLLING IMAGE ORIENTATION
OF SCANNER APPARATUS

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) Examiner: Safaipour, H.
)

) Group Art Unit: 2622
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) Conf. No.: 1757
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) Atty. Dkt.: 10002229-1
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APPEAL BRIEF

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TABLE OF CONTENTS

	Page
REAL PARTY-IN-INTEREST	1
RELATED APPEALS AND INTERFERENCES	1
STATUS OF THE CLAIMS	2
STATUS OF AMENDMENTS	2
SUMMARY OF INVENTION	2
ISSUE	9
GROUPING OF THE CLAIMS	9
ARGUMENT	9
ISSUE: WHETHER CLAIMS 1-20 ARE UNPATENTABLE UNDER 35 U.S.C. §102(e) AS BEING ANTICIPATED BY AKIBA.	9
CONCLUSION	18
APPENDIX A	19
APPENDIX B	25

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TABLE OF AUTHORITIES

Cases:	Page
<i>Hybritech, Inc. v. Monoclonal Antibodies, Inc.</i> , 231 USPQ 81, 90 (Fed. Cir. 1986)	9
<i>Pac-Tec, Inc. v. Amerace Corp.</i> , 14 U.S.P.Q.2d 1871 (Fed. Cir. 1990)	10
<i>Scripps Clinic & Research Foundation v. Genentech, Inc.</i> 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991) ..	9
 Statutes and Regulations:	
35 U.S.C. §102	9, 10

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OF SCANNER APPARATUS)	

APPEAL BRIEF

To: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in response to the final rejections of the claims dated January 29, 2004. A Notice of Appeal was filed on April 29, 2004.

REAL PARTY-IN-INTEREST

The assignee of the entire right, title, and interest in the patent application is Hewlett-Packard Development Company, L.P.

RELATED APPEALS AND INTERFERENCES

There are currently no related appeals or interferences known to Appellants, Appellants' legal representative, or the assignee which will directly affect, or be directly affected by, or have a bearing on, the Board's decision.

STATUS OF THE CLAIMS

Claims 1-20 are pending in the application. Claims 1-20 currently stand rejected. The rejections of claims 1-20 are appealed.

STATUS OF AMENDMENTS

No amendments were filed or entered subsequent to the final office action mailed on January 29, 2004.

SUMMARY OF INVENTION

This invention relates to scanner devices in general and more specifically to apparatus and methods for controlling the displayed orientation of scanned images. The invention as claimed is summarized below with reference to the independent claims which contain reference numerals and reference to the specification and drawings. All references are shown in the application at least where indicated herein.

(Claim 1) Image display orientation control apparatus (10, 110, Figures 2-5; p.8, l. 1-p. 10, l. 34; p. 12, l. 13-p. 19, l. 5) for use with scanner apparatus (3, 103, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) and display apparatus (11, 111, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) operatively associated with the scanner apparatus (3, 103), comprising:

a first setting (12, 112, Figures 2 and 4; p. 8, l. 16-p. 9, l. 11; p. 9, l. 25-p. 10, l. 34; p. 12, l. 33-p. 13, l. 33; p. 14, l. 13-22; p. 16, l. 26-p. 18, l. 22), said first setting (12) causing an image (9, Figure 2) of an object (5, 5', 105, 105' Figures 2-5) scanned by said scanner apparatus (3, 103) to be displayed on said display apparatus (11, 111) in a first orientation (16, Figure 2), said first setting (12) being preserved for subsequent uses of said scanner apparatus (3, 103) until changed by a user (p. 9, l. 5-11; p. 10, l. 29-35; p. 13, l. 14-18 and l. 27-33; p. 17, l. 29-34; p. 18, l. 12-22); and

a second setting (14, 114, Figures 3 and 5; p. 9, l. 12 - p. 10, l. 34; p. 13, l. 34-p. 14, l. 12; p. 16, l. 26-p. 18, l. 22), said second setting (14) causing said image (9', Figure 3) to be displayed on said display apparatus (11, 111) in a second orientation (18, Figure 3), said second setting (14) being preserved for subsequent uses of said scanner apparatus (3, 103) until changed by said user (p. 9, l. 18-24; p. 10, l. 29-34; p. 13, l. 14-18; p. 14, l. 6-12; p. 17, l. 29-34; p. 18, l. 12-22).

(Claim 7) Image display orientation control apparatus (10, 110, Figures 2-5; p. 8, l. 1-p. 10, l. 34; p. 12, l. 13-p. 19, l. 5) for use with scanner apparatus (3, 103, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) and display apparatus (11, 111, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) operatively associated with the scanner apparatus (3, 103), comprising a plurality of settings (12, 14, 112, 114, Figures 2-5; p. 8, l. 16-p. 10, l. 34; p. 12, l. 33-p. 14, l. 13-22; p. 16, l. 26-p. 18, l. 22), each of said plurality of settings (12, 14, 112, 114) causing an image (9, 9', Figures 2 and 3) of an object (5, 5', 105, 105', Figures 2-5) scanned by said scanner apparatus (3, 103) to be displayed on said display apparatus (11, 111) in a corresponding one of a plurality of orientations (16, 18, Figures 2 and 3), each of said plurality of settings (12, 14, 112, 114) being preserved for subsequent uses of said scanner apparatus (3, 103) until changed by a user (p. 9, l. 5-11 and 18-24; p. 10, l. 29-34; p. 13, l. 14-18; p. 13, l. 27-p. 14, l. 12; p. 17, l. 29-34; p. 18, l. 12-22).

(Claim 8) Scanner apparatus (3, 103 Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32), comprising:
a housing (13, 113 Figures 2-5; p. 14, l. 15-18; p. 15, l. 23 and 24); having at least one opening therein;
a scanning device mounted within said housing (13, 113);
a transparent platen (19, 119, Figures 2-5) mounted within the at least one opening in said housing (13, 113), said transparent platen (19, 119) allowing an object (5, 5', 105, 105', Figures 2-5) positioned adjacent said transparent platen (19, 119) to be scanned by said scanning

device; and

a switch (20, 122, Figures 2-5; p. 8, l. 16-p. 10, l. 1; p. 13, l. 19-33; p. 14, l. 13-28), said switch (20, 122) allowing a user to select a first setting (12, 112, Figures 2 and 4; p. 8, l. 16-p. 9, l. 11; p. 9, l. 25-p. 10, l. 34; p. 12, l. 33-p. 13, l. 33; p. 14, l. 13-22; p. 16, l. 26-p. 18, l. 22) or a second setting (14, 114, Figures 3 and 5; p. 9, l. 12 - p. 10, l. 34; p. 13, l. 34-p. 14, l. 12; p. 16, l. 26-p. 18, l. 22), said first setting (12, 112) causing an image (9, Figure 2) of said object (5, 5', 105, 105') to be displayed on a display apparatus (11, 111, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) operatively associated with said scanner apparatus (3, 103) in a first orientation (16, Figure 2), said second setting (14, 114) causing said image (9') to be displayed on said display apparatus (11, 111) in a second orientation (18, Figure 3), said first setting (12, 112) being preserved for subsequent uses of said scanner apparatus (3, 103) until changed by said user, said second setting (14, 114) being preserved for subsequent uses of said scanner apparatus (3, 103) until changed by said user (p. 9, l. 5-11 and 18-24; p. 10, l. 29-34; p. 13, l. 14-18; p. 13, l. 27-p. 14, l. 12; p. 17, l. 29-34; p. 18, l. 12-22).

(Claim 13) Image display orientation control software for use with scanner apparatus (3, 103, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) and display apparatus (11, 111, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) operatively associated with the scanner apparatus (3, 103), comprising:

a first setting (12, 112, Figures 2 and 4; p. 8, l. 16-p. 9, l. 11; p. 9, l. 25-p. 10, l. 34; p. 12, l. 33-p. 13, l. 33; p. 14, l. 13-22; p. 16, l. 26-p. 18, l. 22), said first setting (12, 112) causing an image (9, Figure 2) of an object (5, 5', 105, 105', Figures 2-5) scanned by said scanner apparatus (3, 103) to be displayed on said display apparatus (11, 111) in a first orientation (16, Figure 2), said first setting (12, 112) being preserved for subsequent uses of said image display orientation control software until changed by a user (p. 9, l. 5-11; p. 10, l. 29-35; p. 13, l. 14-18 and l. 27-33; p. 17, l. 29-34; p. 18, l. 12-22); and

a second setting (14, 114, Figures 3 and 5; p. 9, l. 12 - p. 10, l. 34; p. 13, l. 34-p. 14, l.

12; p. 16, l. 26-p. 18, l. 22), said second setting causing said image (9', Figure 3) to be displayed on said display apparatus (11, 111) in a second orientation (18, Figure 3), said second setting (14, 114) being preserved for subsequent uses of said image display orientation control software until changed by said user (p. 9, l. 18-24; p. 10, l. 29-34; p. 13, l. 14-18; p. 14, l. 6-12; p. 17, l. 29-34; p. 18, l. 12-22).

(Claim 14) A scanning system, comprising:

scanner apparatus (3, 103, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32), said scanner apparatus (3, 103) producing an image data signal representative of an object (5, 5', 105, 105', Figures 2-5) being scanned;

display apparatus (11, 111, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) operatively associated with said scanner apparatus (3, 103) and responsive to the image data signal, said display apparatus (11, 111) displaying an image (9, 9', Figures 2 and 3) of the object (5, 5', 105, 105'); and

image display orientation control apparatus (10, 110, Figures 2-5; p. 8, l. 1-p. 10, l. 34; p. 12, l. 13-p. 19, l. 5) operatively associated with said scanner apparatus (3, 103) and said display apparatus (11, 111), said image display orientation control apparatus (10, 110) operable in a first setting (12, 112, Figures 2 and 4; p. 8, l. 16-p. 9, l. 11; p. 9, l. 25-p. 10, l. 34; p. 12, l. 33-p. 13, l. 33; p. 14, l. 13-22; p. 16, l. 26-p. 18, l. 22) and a second setting (14, 114, Figures 3 and 5; p. 9, l. 12 - p. 10, l. 34; p. 13, l. 34-p. 14, l. 12; p. 16, l. 26-p. 18, l. 22), the first setting (12, 112) causing said display apparatus (11, 111) to display the image (9) of the object (5, 5', 105, 105') in a first orientation (16, Figure 2), the second setting (14, 114) causing said display apparatus (11, 111) to display the image (9') of the object (5, 5', 105, 105') in a second orientation (18, Figure 3), the first and second settings (12, 112, 14, 114) of said image display orientation control apparatus (10, 110) being selectable by a user so that the first setting (12, 112) is preserved for subsequent uses of said scanner apparatus (3, 103) when the first setting

(12, 112) is selected by the user (p. 9, l. 5-11; p. 10, l. 29-35; p. 13, l. 14-18 and l. 27-33; p. 17, l. 29-34; p. 18, l. 12-22) and so that the second setting (14, 114) is preserved for subsequent uses of said scanner apparatus (3, 103) when the second setting (14, 114) is selected by the user (p. 9, l. 18-24; p. 10, l. 29-34; p. 13, l. 14-18; p. 14, l. 6-12; p. 17, l. 29-34; p. 18, l. 12-22).

(Claim 18) Image display orientation control apparatus (10, 110, Figures 2-5; p. 8, l. 1-p. 10, l. 34; p. 12, l. 13-p. 19, l. 5) for use with scanner apparatus (3, 103, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) and display apparatus (11, 111, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) operatively associated with the scanner apparatus (3, 103), comprising:

first means (12, 112, Figures 2 and 4; p. 8, l. 16-p. 9, l. 11; p. 9, l. 25-p. 10, l. 34; p. 12, l. 33-p. 13, l. 33; p. 14, l. 13-22; p. 16, l. 26-p. 18, l. 22) for causing an image (9, Figure 2) of an object (5, 5', 105, 105', Figures 2-5) scanned by said scanner apparatus (3, 103) to be displayed on said display apparatus (11, 111) in a first orientation (16, Figure 2), said first means (12, 112) being preserved for subsequent uses of said scanner apparatus (3, 103) until changed by a user (p. 9, l. 5-11; p. 10, l. 29-35; p. 13, l. 14-18 and l. 27-33; p. 17, l. 29-34; p. 18, l. 12-22); and

second means (14, 114, Figures 3 and 5; p. 9, l. 12 - p. 10, l. 34; p. 13, l. 34-p. 14, l. 12; p. 16, l. 26-p. 18, l. 22) for causing said image (9', Figure 3) to be displayed on said display apparatus (11, 111) in a second orientation (18, Figure 3), said second means (14, 114) being preserved for subsequent uses of said scanner apparatus (3, 103) until changed by said user (p. 9, l. 18-24; p. 10, l. 29-34; p. 13, l. 14-18; p. 14, l. 6-12; p. 17, l. 29-34; p. 18, l. 12-22).

(Claim 19) A method (26, Figure 6; p. 10, l. 2-34; p. 16, l. 26-p. 17, l. 34) for controlling image display orientation of scanner apparatus (3, 103, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) and display apparatus (11, 111, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) operatively associated with the scanner apparatus (3, 103), comprising:

providing image display orientation control apparatus (10, 110, Figures 2-5; p. 8, l. 1-p.

10, l. 34; p. 12, l. 13-p. 19, l. 5) operatively associated with said scanner apparatus (3, 103) and said display apparatus (11, 111), said image display orientation control apparatus (10, 110) operable in a first setting (12, 112, Figures 2 and 4; p. 8, l. 16-p. 9, l. 11; p. 9, l. 25-p. 10, l. 34; p. 12, l. 33-p. 13, l. 33; p. 14, l. 13-22; p. 16, l. 26-p. 18, l. 22) and a second setting (14, 114, Figures 3 and 5; p. 9, l. 12 - p. 10, l. 34; p. 13, l. 34-p. 14, l. 12; p. 16, l. 26-p. 18, l. 22), the first setting (12, 112) causing said display apparatus (11, 111) to display an image (9, Figure 2) of an object (5, 5', 105, 105', Figures 2-5) scanned by said scanner apparatus (3, 103) in a first orientation (16, Figure 2), the second setting (14, 114) causing said display apparatus (11, 111) to display said image (9', Figure 3) in a second orientation (18, Figure 3), the first and second settings (12, 112, 14, 114) of said image display orientation control apparatus (10, 110) being selectable by a user so that the first setting (12, 112) is preserved for subsequent uses of said scanner apparatus (3, 103) when the first setting (12, 112) is selected by the user (p. 9, l. 5-11; p. 10, l. 29-35; p. 13, l. 14-18 and l. 27-33; p. 17, l. 29-34; p. 18, l. 12-22) and so that the second setting (14, 114) is preserved for subsequent uses of said scanner apparatus (3, 103) when the second setting (14, 114) is selected by the user (p. 9, l. 18-24; p. 10, l. 29-34; p. 13, l. 14-18; p. 14, l. 6-12; p. 17, l. 29-34; p. 18, l. 12-22);

selecting (28, Figure 6; p. 10, l. 2-34; p. 16, l. 26-p. 17, l. 34) said first setting (12, 112) so that said display apparatus (11, 111) displays said image (9) in said first orientation (16); or, in the alternative,

selecting (28) said second setting (14, 114) so that said display apparatus (11, 111) displays said image (9') in said second orientation (18)(3, 103, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32); and

operating (30, Figure 6; p. 10, l. 2-34; p. 16, l. 26-p. 17, l. 34) said scanner apparatus (3, 103).

(Claim 20) A method (26, Figure 6; p. 10, l. 2-34; p. 16, l. 26-p. 17, l. 34) for controlling

image display orientation of scanner apparatus (3, 103, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) and display apparatus (11, 111, Figures 2-5; p. 8, l. 1-15; p. 12, l. 13-32) operatively associated with the scanner apparatus (3, 103), comprising:

selecting (28, Figure 6; p. 10, l. 2-34; p. 16, l. 26-p. 17, l. 34) a first orientation (12, 112, Figures 2 and 4; p. 8, l. 16-p. 9, l. 11; p. 9, l. 25-p. 10, l. 34; p. 12, l. 33-p. 13, l. 33; p. 14, l. 13-22; p. 16, l. 26-p. 18, l. 22) or a second orientation (14, 114, Figures 3 and 5; p. 9, l. 12 - p. 10, l. 34; p. 13, l. 34-p. 14, l. 12; p. 16, l. 26-p. 18, l. 22), said first orientation being preserved for subsequent uses of said scanner apparatus (3, 103) until changed by a user (p. 9, l. 5-11; p. 10, l. 29-35; p. 13, l. 14-18 and l. 27-33; p. 17, l. 29-34; p. 18, l. 12-22), said second orientation being preserved for subsequent uses of said scanner apparatus (3, 103) until changed by the user (p. 9, l. 18-24; p. 10, l. 29-34; p. 13, l. 14-18; p. 14, l. 6-12; p. 17, l. 29-34; p. 18, l. 12-22);

operating (30, Figure 6; p. 10, l. 2-34; p. 16, l. 26-p. 17, l. 34) said scanner apparatus (3, 103) to scan an object (5, 5', 105, 105', Figures 2-5) positioned adjacent a scanning bed (19, 119, Figures 2-5) of said scanner apparatus (3, 103) and to obtain an image data signal representative of said object (5, 5', 105, 105') in said first orientation (12, 112);

processing (32, 34, Figure 6; p. 10, l. 2-34; p. 16, l. 26-p. 17, l. 34) said image data signal so that said display apparatus (11, 111) displays an image (9, Figure 2) of said object (5, 5', 105, 105') in said first orientation (16, Figure 2) when said first orientation (12, 112) is selected and so that said display apparatus (11, 111) displays the image (9' Figure 3) of said object (5, 5', 105, 105') in said second orientation (18, Figure 3) when said second orientation (14, 114) is selected;

displaying (36, Figure 6; p. 10, l. 2-34; p. 16, l. 26-p. 17, l. 34) the image (9) of said object (5, 5', 105, 105') in said first orientation (16) on said display apparatus (11, 111) when said first orientation (12, 112) is selected, or in the alternative;

displaying (36, Figure 6; p. 10, l. 2-34; p. 16, l. 26-p. 17, l. 34) the image (9') of said object (5, 5', 105, 105') in said second orientation (18) on said display apparatus (11, 111) when

said second orientation (14, 114) is selected.

ISSUE

Whether claims 1-20 are unpatentable under 35 U.S.C. §102(e) as being anticipated by Akiba *et al.*, U.S. Patent No. 6,559,967 (Akiba).

GROUPING OF THE CLAIMS

Claims 2-20 stand or fall with claim 1. That is, there is one group, comprising claims 1-20.

ARGUMENT

Opening Statement

The Akiba reference fails to disclose apparatus and methods that meet the limitations of the pending claims. In addition, the Akiba reference *specifically excludes* from its disclosure certain of the limitations contained in the pending claims. Because there can be no identity to that which is claimed when it is ruled-out by the prior art, the Akiba reference cannot anticipate the pending claims.

**ISSUE: WHETHER CLAIMS 1-20 ARE UNPATENTABLE UNDER 35 U.S.C. §102(e) AS
 BEING ANTICIPATED BY AKIBA.**

Legal Standard For Rejecting Claims Under 35 U.S.C. §102

The standard for lack of novelty, that is, for “anticipation,” under 35 U.S.C. Section 102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.* 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991). Furthermore, functional language, preambles, and language in “whereby,” “thereby,” and

“adapted to” clauses cannot be disregarded. *Pac-Tec, Inc. v. Amerace Corp.*, 14 U.S.P.Q.2d 1871 (Fed. Cir. 1990).

The Akiba Patent

The Akiba patent discloses a multi-function digital copier of the type that may be used in a stand-alone mode to make photocopies or in a mailbox mode to print copies from electronic files sent by a host computer to the copier mailbox. The Akiba reference focuses on providing the copier with an improved mailbox function wherein the display device provided on the copier itself may be conveniently used to allow the user to change the printing mode previously selected by the host computer. By displaying the various printing modes on the display provided on the copier itself, a user at the control panel of the copier may review and/or change the printing mode previously selected by the host computer without the need for the user to remember the originally-selected printing mode. See, for example, Akiba at col. 1, lines 52-58. In addition, the Akiba reference contains a general description of the functions and operations of the copier when operated in either the stand alone mode or the mailbox mode. While Akiba reference illustrates the display of two different document orientations on the front panel display, the document orientations are not images of the actual scanned document, but rather generic depictions of a document. See, for example, Figure 8, items 801 and 802 of Akiba.

The Examiner’s Rejections

The examiner rejected claims 1-20 under 35 U.S.C. §102(e) as being anticipated by Akiba. These rejections are improper in that, contrary to the examiner’s assertions, Akiba fails to disclose apparatus and methods that meet the limitations of the pending claims. Therefore, Akiba cannot anticipate claims 1-20.

Claim 1 of the present application is directed to image display orientation control apparatus that comprises a first setting and a second setting. The first setting causes an image of an object scanned by a scanner apparatus to be displayed in a first orientation. The second setting causes the image to be

displayed in a second orientation. Claim 1 also requires that the first setting be “preserved for subsequent uses of the scanner apparatus until changed by a user.” At least these limitations of claim 1 are not met by Akiba.

The examiner cites to two different portions of the Akiba disclosure to support his anticipation rejections. However, neither portion supports the proposition that Akiba anticipates claim 1. In the first portion cited by the examiner, contained at col 9, lines 46-50, Akiba discloses that the copier has setting keys 801 and 802 (Figure 8) that instruct the copier to print the copies for bound sheets in either a right/left opening or an up/down opening. Akiba then goes on to say that “[i]n this embodiment, the direction (orientation) of document (portrait or landscape) is defined as shown in FIG 9.” While it is not clear whether the setting keys 801 and 802 change the direction (i.e., orientation) of the original document or whether they control the orientation of the copies (i.e., right/left opening or up/down opening), what is clear is that Akiba makes no mention as to whether either setting is preserved for subsequent uses of the copier until changed by a user. In addition, the settings of Akiba relate to *printing modes* for the copier, not to display orientations as in claim 1.

The second portion of Akiba cited by the examiner, contained in col. 6, lines 57-64, also fails to support the proposition that Akiba anticipates claim 1. The second portion of Akiba states as follows:

“The image memory unit 405 is also used in a case in which, when transmitting an image read by the copier 100 to the host computer 1000 via the computer interface unit 403 (an image scanner function), image data from the image memory unit 3 is developed and converted into a data format suitable for transmission to the host computer 1000, and resultant data is transmitted from the computer interface unit 403.”

This statement merely describes that the copier may be used in an image scanner function to send image data to the host computer. The statement says nothing about a document orientation setting, much less whether any setting is preserved for subsequent uses until changed by a user.

In the final office action, paper no. 5, dated January 29, 2004, the examiner attempts to rebut these teachings of Akiba and the arguments made by the applicant by stating that “Akiba discloses that the user may change the original mode (set by the host computer) by pressing the appropriate buttons on the operation unit and may return the mode to the original mode by pressing the renewed button.” See,

page 2 of the final office action. For support, the examiner then refers to the abstract and to col. 24, lines 34-61 of the Akiba reference.

While it may be possible to reach this conclusion based on the language contained in the abstract and at col. 24, lines 61, a full reading of Akiba reveals that there are certain exceptions to this conclusion, two of which are key to the anticipation issue. The first key exception relates to image-data rotation processing: Akiba *specifically excludes* image-data rotation processes from those setting items that can be changed by a user. For example, in describing the process by which image data may be set by a user, Akiba states as follows:

“In order to faithfully reproduce image data formed by the host computer 1000. . . setting items relating to predetermined processing for image data to be performed before processing of forming an image on a sheet (for example, . . . **image data rotation processing. . .) are not allowed to be changed by the user, and renewed setting relating to the predetermined processing for the image data is prohibited in advance.**” Akiba, col. 23, line 60 - col. 24, line 5 (emphasis added).

It is clear from this passage that Akiba specifically excludes the situation wherein image data rotation processing can be changed by the user.

Any doubt about which operations are to be excluded by Akiba is erased by the statement that immediately follows the above-referenced quotation:

“On the other hand, CPU 171 may perform control **such that other setting items. . . [examples omitted for clarity] . . . are allowed to be changed by the user, so that renewed setting of these items is allowed.**” Akiba, col. 23, lines 5-14.

Notably, none of the examples refer to image-data rotation processing, because image-data rotation processing is specifically mentioned by Akiba as a setting item that *cannot* be changed by a user.

It is beyond question, then, that while Akiba allows certain setting items to be changed by a user (i.e., so that “renewed setting of these items is allowed”), Akiba *specifically excludes* image-data rotation processing from those setting items that can be changed (i.e., “renewedly changed” in the language of Akiba) by the user:

The second key exception is that Akiba’s settings relate to printing modes set by the host

computer, not to display orientations as in the pending claims. See, for example, the abstract of Akiba:

“The copier performs control so that a **printing mode** changed through an operation unit returns to a **printing mode** set by the host computer in accordance with a predetermined instruction.”

In addition, these teachings of Akiba that relate to the setting of the printing mode apply to image data generated by the host computer 1000 (i.e., when the Akiba device is used as a printer), not to image data produced as a result of operating the Akiba device as a scanner. Therefore, any attempt to rely on these teachings is inapt because the teachings relate to a different operational mode of the Akiba device.

Akiba also fails to meet the limitations of claim 1 wherein the first and second settings cause “an image of an object scanned by said scanner apparatus to be displayed on said display apparatus.” While Akiba’s display (e.g., illustrated in Figure 8) illustrates portrait and landscape modes, they are depictions of a generic document only. They are not images of the scanned object, as required by claim 1.

In summation, the Akiba reference fails to disclose at least one limitation of claim 1, i.e., that the first setting be “preserved for subsequent uses. . . until changed by a user,” because Akiba specifically excludes this possibility. Stated another way, because the “first setting” of claim 1 causes the scanned image to be displayed in a first orientation, and because Akiba specifically excludes image-data rotation processing from those setting items that can be changed, Akiba cannot anticipate claim 1. There can be no identity to that which is claimed when it is ruled-out by the prior art.

Claim 1 also requires that the second setting be “preserved for subsequent uses. . . until changed by a user.” The second setting causes the scanned image to be displayed in a second orientation. Again, because Akiba specifically excludes image-data rotation processing from those setting items that can be changed, Akiba cannot anticipate claim 1. In addition, the teachings of Akiba relied-on by the examiner to support the anticipation rejections relate to printing modes set by the host computer, not to display orientations of claim 1. Akiba also fails to disclose first and second settings that cause “an image of the object scanned by said scanner apparatus” to be displayed on “display apparatus,” as required by claim 1. Akiba’s displays of portrait and landscape modes are generic only, and are not an image of the object scanned by a scanner.

Dependent claims 2-6 are allowable in that they depend from claim 1, which is allowable.

Independent claim 7 is allowable because Akiba does not meet the limitation of claim 7 that the image display orientation control apparatus comprise a “plurality of settings,” each of which is “preserved for subsequent uses of the scanner apparatus until changed by a user.” Each of the “plurality of settings” of claim 7 causes the scanned image to be displayed in “a corresponding one of a plurality of rotations.” Akiba specifically excludes image-data rotation processing from those setting items that can be changed. Therefore, Akiba cannot meet the limitations of claim 7.

In addition, claim 7 requires that each respective setting of the plurality settings be preserved “for subsequent uses of said scanner apparatus until changed by a user.” Even if Akiba disclosed preserving an image orientation setting for subsequent uses until changed by a user, which it specifically does not, Akiba’s teachings in this regard relate to image data produced by the host computer 1000, not to image data resulting from a scanning operation. Akiba’s settings also relate to printing modes set by the host computer, not to the display orientations of claim 7. Akiba also fails to disclose a plurality of settings that cause “an image of the object scanned by said scanner apparatus” to be displayed on “display apparatus.” Akiba’s displays of portrait and landscape modes are generic only, and are not an image of the object scanned by a scanner.

Independent claim 8 is allowable because Akiba does not meet the limitations specifically set forth in claim 8. That is, Akiba does not disclose a switch that allows a user to select a first setting, wherein the first setting is “preserved for subsequent uses of said scanner apparatus until changed by a user.” Akiba also does not disclose a switch that allows a user to select a second setting, wherein the second setting is “preserved for subsequent uses of said scanner apparatus until changed by said user.” Akiba specifically excludes image-data rotation processing from those setting items that can be changed. Akiba’s setting items also relate to printing modes set by the host computer, not to the display orientations of claim 8. Therefore, Akiba cannot anticipate claim 8.

Claim 8 also requires that the settings be preserved “for subsequent uses of said scanner apparatus until changed by a user.” Therefore, even if Akiba disclosed preserving an image orientation

for subsequent uses until changed by a user, which it does not, Akiba's teachings in this regard relate to image data produced by the host computer 1000, not to image data resulting from a scanning operation. Akiba also fails to disclose first and second settings that cause "an image of the object scanned by said scanner apparatus" to be displayed on "display apparatus," as required by claim 8. Akiba's displays of portrait and landscape modes are generic only, and are not an image of the object scanned by a scanner. Therefore, Akiba still would not meet the limitations of claim 8.

Dependent claims 9-12 are allowable in that they depend from claim 8, which is allowable.

Independent claim 13 is allowable because Akiba fails to disclose image display orientation control software that meets the limitations specifically set forth in claim 13. That is, Akiba does not disclose software that, when operated in a first setting, causes an image of the scanned object to be displayed in a first orientation, the first setting being "preserved for subsequent uses of said scanner apparatus until changed by a user." Akiba specifically excludes image-data rotation processing from those setting items that can be changed. Therefore, Akiba cannot anticipate claim 13.

Claim 13 also requires that when the software is operated in a second setting, an image of the scanned object will be displayed in a second orientation, the second setting being "preserved for subsequent uses of said scanner apparatus until changed by said user." Again, Akiba specifically excludes image-data rotation processing from those setting items that can be changed by a user, much less be preserved for subsequent uses until changed by the user. Stated another way, if a user cannot change the setting of the image-data rotation processing in Akiba in the first place, there is no way that Akiba can preserve a setting for subsequent uses until changed by the user. Moreover, Akiba's teachings about what settings can and cannot be set by a user specifically relate to image data produced by the host computer 1000, not to image data resulting from a scanning operation. The setting modes also specifically relate to printing modes set by the host computer, not to the display orientations of claim 13.

Akiba also fails to meet the limitations of claim 13 wherein first and second settings cause "an image of the object scanned by said scanner apparatus" to be displayed on "display apparatus." Akiba's displays of portrait and landscape modes are generic only, and are not an image of the object scanned by

a scanner. Because Akiba fails to meet all of the limitations set forth in claim 13, Akiba cannot anticipate claim 13.

Independent claim 14 is directed to a scanning system that includes a scanner apparatus, display apparatus, and image display orientation control apparatus. The image display orientation control apparatus of claim 14 is operable in a first setting which causes an image of the scanned object to be displayed in a first orientation. The first setting is “selectable by a user so that the first setting is preserved for subsequent uses of said scanner apparatus when the first setting is selected by the user.” Akiba does not meet this limitation because Akiba’s image orientation settings are not selectable by a user. It follows, then, that Akiba’s image orientation setting cannot be preserved for subsequent uses until changed by a user. In addition, Akiba’s settings relate to the printing mode set by the host computer, not to the display orientations of claim 14. Therefore, Akiba cannot anticipate independent claim 14.

The image display orientation control apparatus of claim 14 is also operable in a second setting which causes an image of the scanned object to be displayed in a second orientation. The second setting is “selectable by a user. . . so that the second setting is preserved for subsequent uses of said scanner apparatus when the second setting is selected by the user.” Again, because Akiba’s image orientation settings are not selectable by a user, Akiba also fails to meet this limitation of claim 14.

Akiba also fails to meet the limitations of claim 14 wherein first and second settings of the image display orientation control apparatus cause “an image of the object scanned by said scanner apparatus” to be displayed on “display apparatus.” Akiba’s displays of portrait and landscape modes are generic only, and are not an image of the object scanned by a scanner.

Dependent claims 15-17 are allowable in that they depend from claim 14, which is allowable.

Independent claim 18 is directed to image display orientation control apparatus comprising “first means” for causing a scanned image to be displayed in a first orientation. Claim 18 requires the first means to be “preserved for subsequent uses of said scanner apparatus until changed by a user.” Akiba cannot meet this limitation because Akiba specifically excludes image data rotation processing from

those setting items that can be changed by a user. Accordingly, claim 18 is not anticipated by Akiba.

Claim 18 also comprises “second means” that causes the scanned image to be displayed in a second orientation. The second means of claim 18 is also “preserved for subsequent uses of said scanner apparatus until changed by said user.” Because Akiba excludes image data rotation processing from those setting items that can be changed by a user, Akiba cannot meet this limitation of claim 18. Another difference between claim 18 and Akiba is that the settings of Akiba relate to printing modes set by the host, not to the display orientations of claim 18. In addition, Akiba fails to disclose respective first and second means for causing “an image of the object scanned by said scanner apparatus” to be displayed on “display apparatus.” Akiba’s displays of portrait and landscape modes are generic only, and are not an image of the object scanned by a scanner. Therefore, claim 18 is not anticipated by Akiba.

Independent claim 19 is directed to a method that comprises providing image display orientation control apparatus that is “operable in a first setting and a second setting,” which cause display apparatus to display an image of the scanned object in respective first and second orientations. Claim 19 requires that the first and second settings be “selectable by a user” so that the first setting “is preserved for subsequent uses of said scanner apparatus when the first setting is selected by a user” and so that the second setting “is preserved for subsequent uses of said scanner apparatus when the second setting is selected by a user.” Akiba excludes image data rotation processing from those setting items that can be changed by a user. In addition, Akiba’s settings relate specifically to printing modes set by the host computer, not to the display orientation of claim 19. Akiba also fails to meet the limitations of claim 19 wherein first and second settings cause “an image of the object scanned by said scanner apparatus” to be displayed on “display apparatus.” Akiba’s displays of portrait and landscape modes are generic only, and are not an image of the object scanned by a scanner. Therefore, Akiba cannot anticipate method claim 19.

Claim 20 is directed to a method comprising selecting a first orientation or a second orientation, the “first orientation being preserved for subsequent uses of said scanner apparatus until changed by a user, said second orientation being preserved for subsequent uses of said scanner apparatus until changed

by the user.” Akiba specifically excludes image data rotation processing from those setting items that can be changed by a user. Therefore, Akiba does not meet these limitations of claim 20. Even if Akiba disclosed preserving an image orientation for subsequent uses until changed by a user, which it does not, Akiba’s teachings in this regard relate to image data produced by the host computer 1000, not to image data resulting from a scanning operation. Akiba also teaches that the settings relate to the printing mode set by the host computer, not to any display orientation of the type referred to in claim 20. Akiba also fails to disclose “processing the image data signal so that said display apparatus displays an image of the object” in the first and second orientations. Akiba’s displays of portrait and landscape modes are generic only, and are not an image of the object scanned by a scanner. Therefore, Akiba would still not meet the limitations of claim 20.

CONCLUSION

The Akiba reference fails to disclose apparatus and methods that meet all of the limitations of the pending claims. In fact, because the Akiba reference *specifically excludes* from its disclosure certain of the limitations contained in the pending claims, there can be no identity. Without identity, there is no anticipation. Therefore, Appellants respectfully request the Board to reverse the rejections of claims 1-20.

Respectfully submitted,

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Date: 6-23-04

APPENDIX A

1. Image display orientation control apparatus for use with scanner apparatus and display apparatus operatively associated with the scanner apparatus, comprising:
 - a first setting, said first setting causing an image of an object scanned by said scanner apparatus to be displayed on said display apparatus in a first orientation, said first setting being preserved for subsequent uses of said scanner apparatus until changed by a user; and
 - a second setting, said second setting causing said image to be displayed on said display apparatus in a second orientation, said second setting being preserved for subsequent uses of said scanner apparatus until changed by said user.
2. The image display orientation control apparatus of claim 1, wherein said first orientation comprises a portrait orientation, and wherein said second orientation comprises a landscape orientation.
3. The image display orientation control apparatus of claim 1, further comprising a switch operatively associated with said image display orientation control apparatus, said switch allowing said user to select between said first setting and said second setting.
4. The image display orientation control apparatus of claim 3, wherein said switch is mounted to said scanner apparatus.
5. The image display orientation control apparatus of claim 3, wherein said switch is implemented as a user selectable interface that is displayed on said display apparatus.
6. The image display orientation control apparatus of claim 1, further comprising an image data processing system operatively associated with said scanning apparatus and said display apparatus,

said image data processing system receiving an image data signal produced by said scanner apparatus that is representative of said object, said image data processing system processing said image data signal so that said display apparatus displays the image of said object in said first orientation when said first setting is selected by said user and so that said display apparatus displays the image of said object in said second orientation when said second setting is selected by said user.

7. Image display orientation control apparatus for use with scanner apparatus and display apparatus operatively associated with the scanner apparatus, comprising a plurality of settings, each of said plurality of settings causing an image of an object scanned by said scanner apparatus to be displayed on said display apparatus in a corresponding one of a plurality of orientations, each of said plurality of settings being preserved for subsequent uses of said scanner apparatus until changed by a user.

8. Scanner apparatus, comprising:

a housing having at least one opening therein;

a scanning device mounted within said housing;

a transparent platen mounted within the at least one opening in said housing, said transparent platen allowing an object positioned adjacent said transparent platen to be scanned by said scanning device; and

a switch, said switch allowing a user to select a first setting or a second setting, said first setting causing an image of said object to be displayed on a display apparatus operatively associated with said scanner apparatus in a first orientation, said second setting causing said image to be displayed on said display apparatus in a second orientation, said first setting being preserved for subsequent uses of said scanner apparatus until changed by said user, said second setting being preserved for subsequent uses of said scanner apparatus until changed by said user.

9. The scanner apparatus of claim 8, wherein said first orientation comprises a portrait

orientation, and wherein said second orientation comprises a landscape orientation.

10. The scanner apparatus of claim 8, further comprising an image data processing system operatively associated with said scanning apparatus and said display apparatus, said image data processing system receiving an image data signal produced by said scanning device that is representative of said object, said image data processing system processing said image data signal so that said display apparatus displays the image of said object in said first orientation when said first setting is selected by said user and so that said display apparatus displays the image of said object in said second orientation when said second setting is selected by said user.

11. The scanner apparatus of claim 8, wherein said switch is mounted to said scanner apparatus.

12. The scanner apparatus of claim 8, wherein said switch is implemented as a user selectable interface that is displayed on said display apparatus.

13. Image display orientation control software for use with scanner apparatus and display apparatus operatively associated with the scanner apparatus, comprising:

a first setting, said first setting causing an image of an object scanned by said scanner apparatus to be displayed on said display apparatus in a first orientation, said first setting being preserved for subsequent uses of said image display orientation control software until changed by a user; and

a second setting, said second setting causing said image to be displayed on said display apparatus in a second orientation, said second setting being preserved for subsequent uses of said image display orientation control software until changed by said user.

14. A scanning system, comprising:

scanner apparatus, said scanner apparatus producing an image data signal representative of an object being scanned;

display apparatus operatively associated with said scanner apparatus and responsive to the image data signal, said display apparatus displaying an image of the object; and

image display orientation control apparatus operatively associated with said scanner apparatus and said display apparatus, said image display orientation control apparatus operable in a first setting and a second setting, the first setting causing said display apparatus to display the image of the object in a first orientation, the second setting causing said display apparatus to display the image of the object in a second orientation, the first and second settings of said image display orientation control apparatus being selectable by a user so that the first setting is preserved for subsequent uses of said scanner apparatus when the first setting is selected by the user and so that the second setting is preserved for subsequent uses of said scanner apparatus when the second setting is selected by the user.

15. The scanning system of claim 14, wherein said first orientation comprises a portrait orientation, and wherein said second orientation comprises a landscape orientation.

16. The scanning system of claim 14, further comprising a switch operatively associated with said image display orientation control apparatus, said switch allowing the user to select between the first setting and the second setting.

17. The scanning system of claim 14, further comprising an image data processing system operatively associated with said scanner apparatus, said display apparatus and said image display orientation control apparatus, said image data processing system receiving said image data signal produced by said scanner apparatus, said image data processing system processing said image data signal

so that said display apparatus displays the image of said object in said first orientation when said first setting is selected by said user and so that said display apparatus displays the image of said object in said second orientation when said second setting is selected by said user.

18. Image display orientation control apparatus for use with scanner apparatus and display apparatus operatively associated with the scanner apparatus, comprising:

first means for causing an image of an object scanned by said scanner apparatus to be displayed on said display apparatus in a first orientation, said first means being preserved for subsequent uses of said scanner apparatus until changed by a user; and

second means for causing said image to be displayed on said display apparatus in a second orientation, said second means being preserved for subsequent uses of said scanner apparatus until changed by said user.

19. A method for controlling image display orientation of scanner apparatus and display apparatus operatively associated with the scanner apparatus, comprising:

providing image display orientation control apparatus operatively associated with said scanner apparatus and said display apparatus, said image display orientation control apparatus operable in a first setting and a second setting, the first setting causing said display apparatus to display an image of an object scanned by said scanner apparatus in a first orientation, the second setting causing said display apparatus to display said image in a second orientation, the first and second settings of said image display orientation control apparatus being selectable by a user so that the first setting is preserved for subsequent uses of said scanner apparatus when the first setting is selected by the user and so that the second setting is preserved for subsequent uses of said scanner apparatus when the second setting is selected by the user;

selecting said first setting so that said display apparatus displays said image in said first orientation; or, in the alternative,

selecting said second setting so that said display apparatus displays said image in said second orientation; and
operating said scanner apparatus.

20. A method for controlling image display orientation of scanner apparatus and display apparatus operatively associated with the scanner apparatus, comprising:

selecting a first orientation or a second orientation, said first orientation being preserved for subsequent uses of said scanner apparatus until changed by a user, said second orientation being preserved for subsequent uses of said scanner apparatus until changed by the user;

operating said scanner apparatus to scan an object positioned adjacent a scanning bed of said scanner apparatus and to obtain an image data signal representative of said object in said first orientation;

processing said image data signal so that said display apparatus displays an image of said object in said first orientation when said first orientation is selected and so that said display apparatus displays the image of said object in said second orientation when said second orientation is selected;

displaying the image of said object in said first orientation on said display apparatus when said first orientation is selected, or in the alternative;

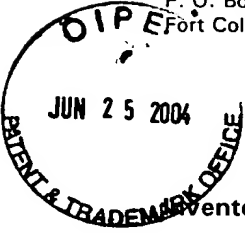
displaying the image of said object in said second orientation on said display apparatus when said second orientation is selected.

APPENDIX B

Reference Relied on By Examiner in his Final Response

A copy of the following reference is attached hereto for the Board's convenience:

- U.S. Patent No. 6,559,967, "Image Storage Apparatus," of Akiba, *et al.*



IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Bruce Votipka, et al.

Confirmation No.: 1757

Application No.: 09/675,514

Examiner: Safaipour, H.

Filing Date: 09/29/2000

Group Art Unit: 2622

Title: METHOD AND APPARATUS FOR CONTROLLING IMAGE ORIENTATION OF SCANNER APPARATUS

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

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JUN 30 2004

Technology Center 2600

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith in **triplicate** is the Appeal Brief in this application with respect to the Notice of Appeal filed on April 29, 2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$330.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$110.00
() two months	\$420.00
() three months	\$950.00
() four months	\$1480.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$330.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

(X) I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450. Date of Deposit: 06-23-2004

OR

() I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number _____ on _____

Number of pages: _____

Typed Name: _____

Signature: _____

Respectfully submitted,

Bruce Votipka, et al.

By _____

Bruce E. Dahl

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Date: 06-23-2004

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AF/2622
B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
Bruce Votipka, et al.)
Serial No.: 09/675,514)
Filing Date: 09/29/2000)
For: METHOD AND APPARATUS FOR)
CONTROLLING IMAGE ORIENTATION)
OF SCANNER APPARATUS)
Docket No.: 10002229-1)

Confirmation No.: 1757

Examiner: H. Safaipour

Group Art Unit: 2622

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CERTIFICATE OF MAILING

I hereby certify that the attached **Transmittal of Appeal Brief (in duplicate); Appeal Brief in triplicate (28 pages with one reference document); and Post cards for return by the United States Patent and Trademark Office**, are all being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, Mail Stop Appeal Brief - Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23rd day of June 2004.

By: Bruce E Dahl
Bruce E. Dahl, Reg. No. 33,670